IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of Wang, Ming-Bo et al. Application No.: 09/287,632 Filed: April 7, 1999 For: Methods and Means for Obtaining Modified Phenotypes	**MAIL STOP: APPEAL BRIEF PATENTS** Group Art Unit: 1635 Examiner: ZARA, JANE J Confirmation No.: 6526

REQUEST FOR REHEARING IN APPEAL NO: 2011-00275

I. INTRODUCTION

A Decision on Appeal in Appeal No 2001-002275 (Application No. 09/287,632) was mailed on March 30, 2012. The Decision on Appeal reversed the Examiner with respect to three of four rejections on appeal. However, the Decision affirmed the Examiner's fourth rejection in which claims 22, 26, 42, 53, 54, 56, 58, 63-69, 100-103, and 115-122 were rejected on the ground of nonstatutory obviousness-type double patenting over claims 35-38 of copending Application No. 11/841,737.

In accordance with 37 C.F.R. § 41.52, the Board is requested to reconsider the affirmance of the rejection of claims 22, 26, 42, 53, 54, 56, 58, 63-69, 100-103, and 115-122 the ground of nonstatutory obviousness-type double patenting over claims 35-38 of copending Application No. 11/841,737.

II. THE REJECTION IS MOOT

The Board appears to have overlooked the fact that the claims of the copending application over which the claims of the present application were rejected were no longer pending at the time the decision was issued. A Notice of Abandonment was mailed in Application No. 11/841,737 on August 8, 2011. Thus, at the time the decision was issued, the rejection was moot.

III. LEGAL PRINCIPLES

When a rejection becomes moot, it is appropriate to dismiss the rejection. *See, e.g., Steffel v. Thompson,* 415 U.S. 452, 459 n.10 (1974) ("The rule in federal cases is that an actual controversy must be extant at all stages of review, not merely at the time the complaint

is filed."). Indeed, it has been routine practice of the Board to dismiss a rejection that becomes moot during the course of an appeal without reaching the merits thereof. *See, e.g., Ex Parte Beatty*, Appeal No. 2009-014443, at 2, n. 2 (BPAI 2012); *Ex Parte Smith*, Appeal No. 2009-013504, at 8 (BPAI 2012); *Ex parte Christensen*, Appeal No. 2009-011855, at 8 (BPAI 2012); *Ex parte Vanyo*, Appeal No. 2010-003774, at 2, n. 1 (BPAI 2012); *Ex parte Blackburn*, Appeal No. 2011-010059, at 4 (BPAI 2012).

IV. REQUESTED RELIEF

Accordingly, the affirmance of the rejection of claims 22, 26, 42, 53, 54, 56, 58, 63-69, 100-103, and 115-122 the ground of nonstatutory obviousness-type double patenting over claims 35-38 of copending Application No. 11/841,737 should be vacated and the rejection should be dismissed as moot. Such action is respectfully requested.

V. RELATED CURRENTLY CO-PENDING APPLICATION

While Application No. 11/841,737 has been abandoned, Appellants note that related Application No. 11/364,183 remains co-pending. It is appellants' position that no new double-patenting rejection should be required. Even if one or more claims of the '183 Application are not separately patentable from the present claims, any rejection would be, for all practical purposes, moot in view of the procedures set forth in MPEP § 804(I)(B)(1).

Any double-patenting rejection over claims of the '183 Application would be provisional at most, and merely transitory. The '183 Application has not issued. The present application was filed prior to the '183 Application. Under the patent examination procedures of the Office, any such provisional rejection would have to be immediately withdrawn. The MPEP states:

> If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. . . .
>
> If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer.

MPEP § 804(I)(B)(1). Nevertheless, Appellants expect that the Examiner will consider the current state of the related application, and the claims pending therein, when this application is returned to the Examiner. If the Examiner considers that a new double patenting rejection is necessary, Appellants will respond to it appropriately as a new ground of rejection.

VI. CONCLUSION

In view of the foregoing, the affirmance of the rejection of claims 22, 26, 42, 53, 54, 56, 58, 63-69, 100-103, and 115-122 the ground of nonstatutory obviousness-type double patenting over claims 35-38 of copending Application No. 11/841,737 should be vacated and the rejection should be dismissed as moot.

Respectfully submitted,

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